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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,981	01/13/2006	Cynthia C. Bamdad	13150-70090US	4121
Jhk Law P.o. box 1078 La Canada, 91012-1078 CANADA	7550 06/30/2008		EXAMINER MCDOWELL, BRIANE	
			ART UNIT 4161	PAPER NUMBER
			MAIL DATE 06/30/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,981

**Applicant(s)**

BAMDAD, CYNTHIA C.

**Examiner**

BRIAN MCDOWELL

**Art Unit**

4161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula II where  $M_1-M_4$  = carbons to form a benzene ring (may be substituted) and  $R_1$  = aryl group which may be substituted.
- II. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula II where  $M_1-M_4$  = carbons to form a benzene ring (may be substituted) and  $R_1$  = a benzyl group ( $-CH_2Ph$ ), which may be substituted.
- III. Claims 1-16 drawn to compounds of Formula II that are not embraced by groups I-II.

- IV. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula IV where  $M_1-M_4$  = carbons to form a benzene ring (may be substituted) and  $M_5-M_{14}$  = carbons to form a naphthalene ring which may be substituted.
- V. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula V where  $M_1-M_4$  = carbons to form a benzene ring (may be substituted) and  $M_5-M_{14}$  = carbons to form a naphthalene ring which may be substituted.
- VI. Claims 1-16 drawn to compounds of Formula IV and V that are not embraced by groups IV-V.
- VII. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula IX where  $M_{25}-M_{28}$  = carbons to form a seven-membered ring.
- VIII. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula IX that is not embraced by group VII.
- IX. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula X where  $M_x$  = carbons to form a benzene ring (may be substituted),  $R_9$  = aryl group (may be substituted) and  $R_8$  and  $R_9$  does not form a cyclic structure.
- X. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula X that is not embraced by group IX.

- XI. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula XI where  $M_X$  = carbons to form a piperazine ring and  $R_{10}$  = a furanyl ring.
- XII. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula XI where  $M_X$  = carbons to form a piperazine ring and  $R_{10}$  = a thienyl ring.
- XIII. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula XI that are not embraced by groups XI—XII.
- XIV. Claims 1-16 drawn to a method of treating or preventing cancer using compounds drawn to Formula XII.
- XV. Claims 17-22 drawn to a method of treating or preventing MUC1-positive cancers.
- XVI. Claim 23 drawn to a method for diagnosing cancer cells.

**Note: Election of a single disclosed chemical specie is required for any group elected. Furthermore, applicant is noted that a further restriction may be required upon election of an invention.**

The inventions listed as Groups I-XVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: US 6,545,004

(document is cited in the ISR) teaches a compound that reads on applicant's claims 2-4 (col. 26, example 4). Therefore, the compounds and methods are not novel and the invention lacks a special technical feature.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the

Art Unit: 1625

prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BEM

/Patrick J. Nolan/  
Supervisory Patent Examiner, Art Unit 4161